

REMARKS

The Office examined claims 1-17 and rejected claims 10-17. With this paper, various of the claims are amended, none are canceled, and no new claims are added, so that claims 1-17 remain in the application.

Rejections under 35 USC §112, first paragraph

At page 2 of the Office action, claim 10 is rejected under 35 USC §112, first paragraph. The Office asserts that "the means in the claim lack an equivalent structure description in the specification."

Applicant respectfully submits that the ground of rejection is improper. Applicant assumes that the Examiner views claim 10 as reciting means plus function elements. Applicant respectfully submits that the claim recites modules that in the specification are indicated as application program interfaces. One skilled in the art of telecommunication would understand such modules as implemented for example as software loaded for execution into a processor, but possibly instead as application specific integrated circuits. The claims recite these modules, and also recite the inputs to the modules and the resulting outputs. This recitation implies processing that can be performed in many different ways, as long as the recited outputs are provided by the modules when the recited inputs are provided to the modules.

Thus, there is a "structure description" (application program interfaces) provided by the specification.

Accordingly, applicant respectfully requests that the rejections under 35 USC §112, first paragraphs, be withdrawn.

Rejections under 35 USC §101

Also at page 2 of the Office action, claims 10-17 are rejected under 35 USC §101, for allegedly not being directed to statutory subject matter.

The grounds stated for the rejection of claim 10 is the same as for the rejection of claim 10 under 35 USC 112, first paragraph. Applicant respectfully submits that for the same reason as given in that respect, the rejection here ought also to be withdrawn.

For claims 11 and 13-17, the Office requests clarification as to whether a "server" where recited in those claims is hardware or software. Applicant respectfully submits that the term "server" is commonly understood as hardware operating according to software, and is used in claims 11 and 13-17 in the commonly understood sense. Without software, which provides the logic by which the server hardware is operative, the server hardware would not respond to an input.

For claim 12, the Office asserts that because "application program interfaces are known in the art to be software, ... the claim contains no hardware elements," and is thus non-statutory. Applicant respectfully submits that one skilled in the art would understand the invention as recited in claim 12 as a user equipment terminal, as that term is explained in the application in the paragraph beginning at page 14, line 1, which reads in relevant part:

The UE can be any of several kinds. ... [T]he UE [can be] a mobile terminal MT (cellular phone). However, other kinds of UEs can advantageously practice the invention as well, including UEs without an integral MT component, but attached to an external MT, such as a laptop computer attached to a MT or to a mobile router, or other devices that communicate with a MT. It is important to understand that the list of devices given here is not intended to be exhaustive. In addition, some devices will not implement the complete

functionality provided by the invention, but will support only a few services/ applications provided by the IMS.

Now as to the meaning of the term "user equipment" recited in claim 12, applicant respectfully submits that it is proper and necessary for the Office to look to the specification to interpret that term. The Federal Circuit, in *Phillips vs. AWH Corp.*, 415 F.3d 1303, 75 USPQ.2d 1321 (Fed. Cir. 2005), an *en banc* decision, explained again that:

[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.

The court further explained:

That starting point [for understanding a claim term] is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. ... Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.

Thus, the claim, as informed by the specification, must be read to include hardware used for telecommunications (such as for example what is commonly designated as a mobile terminal (MT) component, which is commonly understood to indicate hardware including a transceiver and logic for communicating with a radio access network of a wireless communication system), and thus, as one skilled in the art would appreciate, either hardware hosting software to impart to the hardware the recited functionality as part of the overall functionality required for telecommunication, or an application specific integrated circuit included in such a telecommunication device. (See figure 1, showing a user equipment device including an MT component.)

Applicant appreciates that the preamble is non-limiting unless it "breathes life into the claims," as provided in the Manual for Patent Examining Procedure @ 2111.02, "Weight of

Preamble," where it is explained that according to Kropa v. Robie, the preamble is limiting if the preamble is "essential to point out the invention defined by the claim." Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Applicant respectfully submits that since according to the Office the claim elements could be interpreted to mean only software unless the preamble is taken into account, the preamble should here be taken into account, i.e. it should be given patentable weight since it "breathes life into the claims." Thus, the application program interfaces recited in claim 12 must be understood as indicating hardware elements of a user equipment device hosting software, so that the two in combination provide the recited functionality.

Further in this regard, the application program interfaces are recited as responsive to certain inputs. For example, claim 12 recites that the first application program interface is "responsive to an authorization challenge message from a proxy call session control function of a multimedia network." Software per se, i.e. in the abstract, cannot be responsive to an input, since the input cannot occur, and since it does not function. Only software hosted for execution by hardware can respond to an input. (Applicant would insist also that a computer program product, i.e. a disk containing software loadable by hardware for execution by a processor, would be statutory.) Applicant thus respectfully submits that any question as to patentable weight of the preamble notwithstanding, claim 12 cannot fairly be asserted as being directed merely to software, i.e. to software in the abstract, and thus claim 12 must be read as directed to statutory subject matter.

Accordingly, in view of the above explanations and arguments, applicant respectfully requests that the rejections under 35 USC §101 be withdrawn.

Conclusion

For all the foregoing reasons it is believed that all of the claims of the application are in condition for allowance and their passage to issue is earnestly solicited. Applicant's attorney urges the Examiner to call to discuss the present response if anything in the present response is unclear or unpersuasive.

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Date

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